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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/596,967

06/30/2006

Konrad Kaiser

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3279

23646

7590

05/28/2010

BARNES & THORNBURG LLP

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SUITE 900

WASHINGTON, DC 20006-4675

EXAMINER

STRIMBU, GREGORY J

ART UNIT

PAPER NUMBER

3634

NOTIFICATION DATE

DELIVERY MODE

05/28/2010

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

vrobertson@btlaw.com

DocketingPAT-DC@btlaw.com

Office Action Summary

Application No.

10/596,967

Applicant(s)

KAISER ET AL.

Examiner

Gregory J. Strimbu

Art Unit

3634

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 3/11/10.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-48 is/are pending in the application.
- 4a) Of the above claim(s) 2,7-9,16,17,23,24,26-44,46 and 48 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-6,10-15,18-22,25,45 and 47 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 June 2006 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 6/3/09 + 6/30/06
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

Election/Restrictions

Applicant's election with traverse of Group IV in the reply filed on March 11, 2010 is acknowledged. The traversal is on the ground(s) that figures 1, 3, 6 and 7 are generic to the invention. This is not found persuasive because the embodiments of the invention shown in figures 2 and 8 are clearly not disclosed as being used with the embodiment of figures 1, 3, 6 and 7. In other words, the handles of figures 2 and 8 cannot be used with the handle of figures 6 and 7. Therefore, the handle of figures 6 and 7 are not generic.

The requirement is still deemed proper and is therefore made FINAL.

Claims 2, 7-9, 16, 17, 23, 24, 26-44, 46 and 48 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on March 11, 2010.

Drawings

The drawings are objected to because figure 3 is not shown with the proper cross sectional shading in accordance with MPEP 608.02. Each of figures a, b, c, d on the fourth sheet of drawings should be relabeled 4a, 4b, 4c and 4d respectively. Each of figures a, b, c, d on the fifth sheet of drawings should be relabeled 5a, 5b, 5c and 5d respectively. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the

immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

The abstract of the disclosure is objected to because "[t]he invention relates to" on line 1 can be easily implied and therefore should be deleted. On line 3, "to displace" is confusing since it is unclear how the mountings 4 and 6 are able to displace the casement since they only control the displacement of the casement. On line 6, "in various positions" is grammatically awkward and confusing. On line 11, "functions" is grammatically awkward and confusing. On line 12, "several mountings" is confusing since it is unclear whether or not the applicant is referring to the mountings set forth above. Correction is required. See MPEP § 608.01(b).

The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed. It is suggested the applicant amend the title to include the electromechanical devices which control the turning and titling of the casement.

The following guidelines illustrate the preferred layout for the specification of a utility application. These guidelines are suggested for the applicant's use.

Arrangement of the Specification

As provided in 37 CFR 1.77(b), the specification of a utility application should include the following sections in order. Each of the lettered items should appear in upper case, without underlining or bold type, as a section heading. If no text follows the section heading, the phrase "Not Applicable" should follow the section heading:

- (a) TITLE OF THE INVENTION.
- (b) CROSS-REFERENCE TO RELATED APPLICATIONS.
- (c) STATEMENT REGARDING FEDERALLY SPONSORED RESEARCH OR DEVELOPMENT.
- (d) THE NAMES OF THE PARTIES TO A JOINT RESEARCH AGREEMENT.
- (e) INCORPORATION-BY-REFERENCE OF MATERIAL SUBMITTED ON A COMPACT DISC.
- (f) BACKGROUND OF THE INVENTION.
 - (1) Field of the Invention.

- (2) Description of Related Art including information disclosed under 37 CFR 1.97 and 1.98.
- (g) BRIEF SUMMARY OF THE INVENTION.
 - (h) BRIEF DESCRIPTION OF THE SEVERAL VIEWS OF THE DRAWING(S).
 - (i) DETAILED DESCRIPTION OF THE INVENTION.
 - (j) CLAIM OR CLAIMS (commencing on a separate sheet).
 - (k) ABSTRACT OF THE DISCLOSURE (commencing on a separate sheet).
 - (l) SEQUENCE LISTING (See MPEP § 2424 and 37 CFR 1.821-1.825. A "Sequence Listing" is required on paper if the application discloses a nucleotide or amino acid sequence as defined in 37 CFR 1.821(a) and if the required "Sequence Listing" is not submitted as an electronic document on compact disc).

The disclosure is objected to because of the following informalities: the background and summary of the invention should not be under the same heading, "include" on line 2 of paragraph 8 should be changed to --includes-- to avoid confusion; each of figures 4a-4d in paragraph 47 and figures 5a-5d in paragraph 48 should be separately described; "a pivot bearing . . . rotary band" on line 2 of paragraph 54 is grammatically awkward and confusing; "Depending on the . . . for a unit" in paragraph 56 is grammatically awkward and confusing; "functionally in each case" on line 2 of paragraph 57 is grammatically awkward and confusing; "are coupled by one of the . . . mountings 5, 6 and 7" on lines 5-6 of paragraph 57 is grammatically awkward and confusing; "which is arranged on . . . casement position" on lines 1-2 of paragraph 59 is grammatically awkward and confusing; "provides a release" on line 1 of paragraph 61 is confusing since it is unclear how the function element 11 provides a release of the pivot bearing; it appears that "40" on line 10 of paragraph 71 should be changed to --48-- to avoid confusion; "even only" on line 2 of paragraph 78 is grammatically awkward and confusing; "In the rabbit space . . . illustrated" on lines 2-3 of paragraph 80 is grammatically awkward and confusing; "the locking abutment . . . slope" on line 1-2 of

paragraph 86 is grammatically awkward and confusing; "molded radially" on lines 2-3 of paragraph 86 is confusing since it is unclear how the projection is radially molded to the locking bolt. Finally, the applicant should avoid referring to the same element of the invention with different language. For example, the applicant should avoid referring to element 120 as a battery on line 14 of paragraph 100 and as a housing on line 5 of paragraph 102.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

Claims 1, 3-6, 10-15, 18-22, 25, 45 and 47 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Recitations such as "one of switch elements and sensors" on line 9 of claim 1 render the claims indefinite because it is unclear whether or not the applicant is referring to the one of the switching elements and sensors chosen above. In other words, it is unclear how one can choose the switching elements on line 8 and then choose the sensors on line 9. A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. See MPEP § 2173.05(c). Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then

narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claim 1 recites the broad recitation function elements on line 12, and the claim also recites particularly coupling elements on lines 12-13 which is the narrower statement of the range/limitation. Recitations such as "designed for" on line 2 of claim 5 render the claims indefinite because it is unclear what the applicant is attempting to set forth. Is the handle actually for opening and closing of the casement or is it merely designed to be able to open and close the casement? Recitations such as "on the rabbit space" on line 3 of claim 10 render the claims indefinite because it is unclear how a locking element can be on a space. Recitations such as "elements, ," on line 2 of claim 11 appear to be typographical errors. Recitations such as "assigned to" on line 2 of claim 13 render the claims indefinite because it is unclear what spatial relationship the applicant is attempting to set forth. Recitations such as "a parallel/tilt-out casement" on line 2 of claim 19 render the claims indefinite because it is unclear what the applicant is attempting to set forth. What is the casement parallel to? Recitations such as "and/or" on line 2 of claim 25 render the claims indefinite because it is unclear what the applicant is attempting to set forth. Is the applicant setting forth "and" only, "or" only, or "and" or "or"? Recitations such as "means" on line 5 of claim 25 render the claims indefinite

because the applicant has attempted to use a "means" clause to recite a claim element as a means for performing a specified function. However, since no function is specified by the word(s) preceding or following "means," it is impossible to determine the equivalents of the element, as required by 35 U.S.C. 112, sixth paragraph. See *Ex parte Klumb*, 159 USPQ 694 (Bd. App. 1967). Recitations such as "an electric handle system" on line 2 of claim 45 render the claims indefinite because it is unclear whether or not the handle set forth in claim 1 comprises part of the handle system in claim 45. Recitations such as "a window frame" on line 2 of claim 45 render the claims indefinite because it is unclear whether or not the applicant is referring to the window frame set forth in claim 1.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir.

1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1 and 3-6 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 5 and 7 of copending Application No. 11/544,749. Although the conflicting claims are not identical, they are not patentably distinct from each other because the differences in the claims is a matter of semantics. For example, claim 1 of 10/595,967 sets forth a window frame and a casement while claim 5 of 11/544,749 sets forth a blind frame and a leaf. Although the actual words are different, their meanings are essentially the same.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 1 and 3-6, 10, 11-15, 21, 22, 45 and 47 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over

claim 1 of copending Application No. 11/544,644. Although the conflicting claims are not identical, they are not patentably distinct from each other because the differences in the claims is a matter of semantics. For example, claim 1 of 10/595,967 sets forth a window frame and a casement while claim 5 of 11/544,644 sets forth a blind frame and a leaf. Although the actual words are different, their meanings are essentially the same.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 3-6, 10-15, 18-22, 25, 45 and 47 are rejected under 35 U.S.C. 103(a) as being unpatentable over European Patent Publication No. EP 1 323 885 in view of Hempelmann (US 2004/0128914). European Patent Publication No. EP 1 323 885. European Patent Publication No. EP 1 323 885 discloses a window comprising:

a) a window frame 3 and a casement 2; which can be moved relative to the window frame;

b) mountings 4, 5, 6 between the casement and the window frame for moving of the casement relative to the window frame;

c) a handle (not numbered, but shown in figure 1 on the control unit 19), which handle has a grip part which can be moved into different grip positions at the casement, which positions correspond to different operating positions of the casement;

d) one of switching elements and sensors (not shown, but comprising the switching elements or sensors in the control unit 19) for determining the grip positions; and

e) one of the following controlled by one of the switch elements and sensors

i. electromagnetic or electromechanical locking elements 7, 11 between the casement and the window frame,

ii. electromagnetic or electromechanical function elements 6, particularly coupling elements for at least one or more of the mountings, and

iii. an electromechanical driving device 6 for opening and closing the casement.

the handle is connected with one of the locking elements 7, 11 and the mountings 4, 5, 6 without mechanical elements (claim 3);

wherein the window frame 3 and the casement 2 are constructed without connecting rods (claim 4);

a rabbet space (not numbered, but shown in figure 5) between the window frame 3 and the casement 2, and in that at least one or more of the locking elements 11 are arranged and distributed in or on the rabbet space, where the locking elements bridge the rabbet space and lock the casement on the window frame in the closed position of the window, such that at least one locking element is responsive to the grip position of

the handle, and has an electromagnetically or electromechanically acting closing element 7 (claim 10);

a monitoring device 20 (claim 15).

European Patent Publication No. EP 1 323 885 is silent concerning the handle being arranged on the casement.

However, Hempelmann discloses a window comprising a window frame 1, a casement 2, a handle 7 arranged on the casement, the handle having a grip part, wherein the handle is for manually opening and closing the casement (claim 5).

It would have been obvious to one of ordinary skill in the art to mount the handle of European Patent Publication No. EP 1 323 885 on the casement and to provide the handle of European Patent Publication No. EP 1 323 885 with an L-shaped structure, as taught by Hempelmann, to enable a user to more easily manually open and close the leaf.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory J. Strimbu whose telephone number is 571-272-6836. The examiner can normally be reached on Monday through Friday 8:00 to 4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Katherine Mitchell can be reached on 571-272-7069. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Gregory J. Strimbu/
Primary Examiner, Art Unit 3634